



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

52

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,798	10/11/2001	Toshihiro Morita	450100-03537	9574
20999	7590	03/18/2005	EXAMINER	
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			BAYERL, RAYMOND J	
			ART UNIT	PAPER NUMBER

2173

DATE MAILED: 03/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/975,798	Applicant(s) MORITA ET AL.	
	Examiner Raymond J. Bayerl	Art Unit 2173	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2005, 23 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 7 - 15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 7 - 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2173

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

"Information Processing Apparatus and Method, and Program Storing Medium" is descriptive of the exceedingly broad area of technology that concerns information processing. A proper title might mention something about how "rights information" produces a display for "operating contents".

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 8 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claim, to "A program for operating contents", is recited as comprising nothing more than "code" elements. Applicant therefore seeks to claim a computer program *per se*, but this does not meet any of the four statutory classes of invention, since it is not recited as being embodied in a computer readable, tangible medium.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

Art Unit: 2173

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1, 7 – 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schreiber et al. ("Schreiber"; US #6,298,446 B1) in view of Ahmad ("Ahmad"; US #5,925,127).

As per the independent claims 1, 7, 8, directed to "operating contents", Schreiber discloses "obtaining contents and rights information" by receiving the image information and protection status information, and at step 428 it displays this information within the user interface of the protection manager tool. Each folder name, web page file name and image file name is displayed in the user interface with a corresponding icon alongside that indicates its protection status (col 14, lines 15 - 22). The Schreiber arrangement, in addition to permitting "contents" to be downloaded, also accesses information describing the "rights" that the downloading user has to the "contents".

The recited "setting an icon...from different forms of icons representative of permitted operations" is then seen in Schreiber, where a light blue page icon is displayed alongside web pages, some, but not all of whose referenced images are designated as protected, and a white page icon is displayed alongside web pages none of whose referenced image are designated as protected (col 12, lines 51 – 57).

Schreiber, in obtaining enough information to produce the icon displays, is accessing data at the server side in some sufficient form to make the system operable, only Schreiber does not **explicitly** teach the use of “a control flag which indicates the permitted operations regarding the contents”.

However, Ahmad, in MONITORING THE USE OF RENTED SOFTWARE, specifically establishes an instance of a Check-in/Check-out module along with the “contents” of the software program (Abstract). This operates in conjunction with a Software Monitor module, which is made aware of the user's permission to use the program module 100, as well as the time period over which use of the program module 100 is allowed (col 10, lines 21 – 34). Thus, there need to be indicative units of data such as “a control flag” in the Check-in/Check-out module to drive the indications presented to the Ahmad user, in running the software program.

It would therefore have been obvious to a person having ordinary skill in the art at the time of applicant's invention to produce the iconic “rights” display of Schreiber, but with the originating information arising from the kind of “flag” that is separately provided in Ahmad, so that the proper information might appear in the Schreiber display. Motivation rests in Schreiber, where the icon representation is dependent upon the kind of internal data that a “flag” will properly provide.

As per claim 9's “second icon when said control flag indicates permission of importing the contents”, the white page icon, at least, as is seen in Schreiber, indicates such permission, when none of the images are designated as protected. A similar line of reasoning applies to “moving of said contents” in claims 11, 14. Specifically enabled

Art Unit: 2173

and regulated in Ahmad's Check-in/Check-out module, on the other hand, is the matter of whether a "check-in of said contents" is granted "permission" (claims 10, 13) or is subject to "forbidding" (claims 12, 15), all of which would be represented in "icon" shorthand, when the information from Ahmad is provided to a Schreiber interface.

7. Applicant's arguments with respect to claims 1, 7 – 15, filed 13 January 2005, have been considered but are moot in view of the new ground(s) of rejection.


8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Also noted as relevant during the updated search performed in considering this application is Gruse et al., where content usage monitoring for content players occurs.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond J. Bayerl whose telephone number is (571) 272-4045. The examiner can normally be reached on M - Th from 9:00 AM to 4:00 PM ET.

10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca, can be reached on (571) 272-4048. All patent application related correspondence transmitted by FAX **must be directed** to the central FAX number (703) 872-9306.

11. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.


RAYMOND J. BAYERL
PRIMARY EXAMINER
ART UNIT 2173

17 March 2005